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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,994	10/30/2003	Lopa Mishra	P04470US02/BAS	7531

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EXAMINER	
MERTZ, PREMA MARIA	

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/695,994	MISHRA, LOPA	
	Examiner	Art Unit	
	Prema M. Mertz	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 2/21/06, 3/28/06

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18,20 and 21* is/are pending in the application.

4a) Of the above claim(s) *1-18 and 20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-18, 20-21 are pending in the instant application.

Election/Restriction

1. Applicants election with traverse of antibodies to an elf-3 protein of amino acid sequence set forth in SEQ ID NO:7 is acknowledged. The traversal is on the ground(s) that the restriction is improper since the examiner has not shown that examination of antibodies to elf, praja-1 and pk proteins, would entail a serious burden. This argument is not found persuasive because the Examiner has cited art to demonstrate that the Groups drawn to different antibodies to the disparate proteins lack a special technical feature that is unique and is absent from the prior art.

Each of the antibodies to elf, praja-1 and pk proteins does not share a common technical feature, which is based on a common property or special technical feature not found in the prior art. These antibodies are independent and distinct chemical compounds lacking either a common structural property which distinguishes them as a group from structurally related compounds of the prior art or which provides them with a common utility, which is lacking from those prior art elements.

The first claimed invention fails to recite such a feature, since claim 21 recites an antibody to the amino acid sequence of SEQ IDNO:7, which antibody is found in the prior art. The claim encompasses any antibody which can bind to any epitope in the amino acid sequence as set forth in SEQ ID NO:7 and, therefore the claim encompasses an antibody to dystrophin (see WO 89/06286), which has 11 amino acids in common with the elf-3 protein of the instant invention. The reference discloses the antibody (page 6, lines 7-10; pages 27-29) meeting the limitations of an antibody that binds to a polypeptide of the amino acid sequence of SEQ ID

NO:7. Since the first claimed invention lacks a special technical feature, the other claimed inventions cannot share a special technical feature with the first claimed invention.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter as defined by MPEP 808.02, the Examiner has prima facie shown a serious burden of search (see MPEP 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper. Therefore, Groups drawn to antibodies to elf, praja-1 and pk proteins lack a special technical feature that is unique and absent from the prior art and the restriction requirement set forth on 11/21/2005 is proper and is being maintained.

The Groups as delineated in the restriction requirement (11/21/2005) meet the requirements to support a restriction between the Groups.

The requirement is still deemed proper and is therefore made FINAL.

Claim 1-18, 20 are withdrawn from further consideration by the examiner, as being drawn to a non-elected invention.

Specification

2a. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. It is suggested that the title be amended to recite "antibodies to elf-3 protein".

2b. Applicants are requested to update the status of the prior applications to which the instant application is claiming benefit. The status of nonprovisional parent 08/841,349 should be updated and the expression, "Patent No. 5,955,594" should follow the filing date of the parent

application. Furthermore, the status of nonprovisional parent 09/431,184 should be updated and the expression, "Patent No. 6,642,362" should follow the filing date of the parent application.

Claim rejections-35 USC § 112, second paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 21 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 is vague and indefinite because it recites "binds to an amino acid sequence as set forth in SEQ ID NO:7" rather than "binds to a protein consisting of the amino acid sequence as set forth in SEQ ID NO:7", because the specific amino acid sequence is a characteristic or property of the protein.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by WO 89/06286.

The reference discloses an antibody to dystrophin (see page 6, lines 7-10; pages 27-29) which has 11 amino acids 100% identical with elf-3 protein amino acid sequence set forth in SEQ ID NO:7 (see Sequence Comparison 'A' attached). The antibody of the reference meets the

limitations of an antibody that binds to an amino acid sequence as set forth in SEQ ID NO:7.

Therefore, the antibody of the reference anticipates instant claim 21.

Conclusion

No claim is allowable.

Claim 21 is rejected.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (571) 272-0876. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867.

Official papers filed by fax should be directed to (571) 273-8300. Faxed draft or informal communications with the examiner should be directed to (571) 273-0876.

Information regarding the status of an application may be obtained from the Patent application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Prema Mertz

Prema Mertz Ph.D., J.D.
Primary Examiner
Art Unit 1646
March 29, 2006

CC providing improved plant growth and development under at least one stress
CC condition, improved lignin production or improved galactomannan
CC production. This sequence represents a bacterial polypeptide used in the
CC scope of the invention. Note: The sequence data for this patent did not
CC form part of the printed specification but was obtained in electronic
CC format from USPTO at seqdata.uspto.gov/sequence.html.
XX
SQ Sequence 1355 AA;

Query Match 5.0%; Score 11; DB 8; Length 1355;
Best Local Similarity 100.0%; Pred. No. 0.2;
Matches 11; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

Qy 42 VQKKTFTKWVN 52
||||||||||||
Db 79 VQKKTFTKWVN 89

RESULT 42
AEA24046
ID AEA24046 standard; protein; 2000 AA.
XX
AC AEA24046;
XX
DT 11-AUG-2005 (first entry)
XX
DE Human PRO polypeptide SEQ ID NO 588.
XX
KW immune disorder; PRO; Antiinflammatory; Dermatological;
KW Immunosuppressive; Antirheumatic; Antiarthritic; Osteopathic;
KW Muscular-Gen.; Vasotropic; Antianemic; Antipsoriatic; Immunostimulant.
XX
OS Homo sapiens.
XX
PN WO2005051988-A2.
XX
PD 09-JUN-2005.
XX
PF 02-MAR-2004; 2004WO-US006460.
XX
PR 03-MAR-2003; 2003US-0451884P.
XX
PA (GETH) GENENTECH INC.
XX
PI Abbas A, Bodary S, Clark H, Schoenfeld J, Williams PM, Wood WI;
PI Wu TD;
XX
DR WPI; 2005-417958/42.
DR N-PSDB; AEA24045.
XX
PT New nucleic acid encoding PRO polypeptide, useful for diagnosing and
PT treating an immune related disorder, e.g. systemic lupus erythematosus,
PT rheumatoid arthritis, osteoarthritis, autoimmune hemolytic anemia, or
PT psoriasis.
XX
PS Disclosure; SEQ ID NO 588; 966pp; English.
XX
CC The invention relates to an isolated nucleic acid. The polypeptide,
CC compound or composition, and methods are useful for diagnosing and
CC treating an immune related disorder, e.g. systemic lupus erythematosus,
CC rheumatoid arthritis, osteoarthritis, juvenile chronic arthritis,
CC spondyloarthropathies, systemic sclerosis, idiopathic inflammatory
CC myopathies, Sjogren's syndrome, systemic vasculitis, sarcoidosis,
CC autoimmune hemolytic anemia, autoimmune or immune-mediated skin diseases
CC including bullous skin diseases, erythema multiforme and contact
CC dermatitis, psoriasis, lymphadenopathy, splenomegaly and leukopenia. The
CC present sequence represents the amino acid sequence of a human PRO
CC polypeptide.
XX
SQ Sequence 2000 AA;

Query Match 5.0%; Score 11; DB 9; Length 2000;
Best Local Similarity 100.0%; Pred. No. 0.29;
Matches 11; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

Qy 42 VQKKTFTKWVN 52
||||||||||||
Db 70 VQKKTFTKWVN 80

SEQUENCE COMPARISON 'A'

RESULT 43
AAP90373
ID AAP90373 standard; protein; 3685 AA.
XX
AC AAP90373;
XX
DT 29-MAR-1992 (first entry)
XX
DE Sequence encoded by human muscular dystrophy (MD) cDNA.
XX
KW Dystrophin; muscular dystrophy; probe; antibody; diagnosis; prenatal;
KW heterozygote; gene therapy; genetic screening; foetal screening.
XX
OS Homo sapiens.
XX
PN WO8906286-A.
XX
PD 13-JUL-1989.
XX
PF 16-DEC-1988; 88WO-US004504.
XX
PR 22-DEC-1987; 87US-00136618.
XX
PA (CHIL-) CHILDRENS MED CENT.
XX
PI Kunkel LM, Monaco A, Hoffman EP, Koenig M;
XX
DR WPI; 1989-220587/30.
DR N-PSDB; AAN90338.
XX
PT Muscular dystrophy gene - used for prepn. of probes, dystrophic
PT polypeptide and antibodies for diagnosis and therapy of muscular
PT dystrophy.
XX
PS Disclosure; Fig 8; 68pp; English.
XX
CC The inventors claim an MD probe comprising a purified ss NA SQ which
CC hybridises to at least a part of the MD gene; pure dystrophin (DS)
CC polypeptide, purified NA encoding DS and antibodies (Ab) to DS. The
CC probes are equal to or greater than 10b of one of 12 cDNA sequences
CC deposited as ATCC 58666-57677. The MD gene is human, or a murine Dmd gene
XX
SQ Sequence 3685 AA;

Query Match 5.0%; Score 11; DB 1; Length 3685;
Best Local Similarity 100.0%; Pred. No. 0.48;
Matches 11; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

Qy 42 VQKKTFTKWVN 52
||||||||||||
Db 16 VQKKTFTKWVN 26

RESULT 44
AAP90290
ID AAP90290 standard; protein; 3685 AA.
XX
AC AAP90290;
XX
DT 25-MAR-2003 (revised)
DT 10-JAN-1990 (first entry)
XX
DE Human Duchenne muscular dystrophy gene.
XX
KW Duchenne muscular dystrophy; protein deletion; antiserum.
XX